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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,209	02/05/2002	Claudia Kirchner	VO-537	8090

42419 7590 02/13/2006

PAULEY PETERSEN & ERICKSON  
2800 WEST HIGGINS ROAD  
SUITE 365  
HOFFMAN ESTATES, IL 60195

EXAMINER

KOHARSKI, CHRISTOPHER

ART UNIT PAPER NUMBER

3763

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/049,209

Applicant(s)

KIRCHNER, CLAUDIA

Examiner

Christopher D. Koharski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10, 18, 24-33, 36, 37 and 39-54 is/are rejected.
- 7) ☒ Claim(s) 10-17, 19-23, 34, 35, 38, 51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/16/2002.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed 7/12/2002 fails to comply with 37 CFR 1.98(a)(2), which requires a legible translated copy of each cited foreign patent (8714995) document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Specification***

If applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 119(e)/120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the

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application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge

under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.

The disclosure is objected to because of the following informalities: the specification does not use the suggested section headings, "field of invention," "background of the invention," summary of the invention," brief description of the drawings", and "detailed description of the drawings".

Appropriate correction is required.

***Claim Objections/ Allowable Subject Matter***

Claim 10 is objected to because of the following informalities: the language "near one of the" is hard to understand. Appropriate correction is required.

Claim 51 is objected to because of the following informalities: the letter "a" seems to be an error. Appropriate correction is required.

Claims 11-17, 19-23, 34, 35, 38, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: claims 11-17, 19-23, 34, 35, and 38 are allowable over the closest prior art of record Williams et al. (5,749,850) and Bachman et al. (5,843,029). Williams et al. and Bachman et al. describe breast pumps but do not have the combination of the previous claims in addition to the cap element with retaining means to the attachment with ribs elements

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and a soft material cover that uses a pin/bearing connections with a stepped stroke chamber.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1, 2, 26-28, 39-40, 42, 45-46 are rejected under 35 U.S.C. 102(e) as being Williams et al. (5,749,850). Williams et al. discloses a breast pump comprises several elements relating a manual application.

Regarding claims 1, 45-46 Williams et al. discloses a breast pump having an attachment (57) applied to the opening of a container (Figure 7) with a stroke chamber,

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piston, and handle, retracting mechanism, and with a cup shaped element (55) (Figure 8).

Regarding claim 2, Williams et al. discloses a breast pump having a stroke chamber with a handle and a pivot axis (Figure 8).

Regarding claims 26-28, Williams et al. discloses a spring (32) and handle (40) in a piston pump chamber setup (Figure 8) the cap element covers the entire system. The system is oriented with the piston system in relationship to the breast attachment element.

Regarding claim 39, Williams et al. discloses a breast pump with spacer elements that are capable of attaching the container and yet leave space for atmospheric pressure regulation.

Regarding claim 40, Williams et al. discloses a breast pump is the piston rod is hinged with the upper section (Figure 7) and is capable of being removed.

Regarding claim 42, Williams et al. discloses a pump assembly that is capable of being balanced between the handle and the breast attachment element so that it does not tip over.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-7, 18, 24-25, 32-33, 36-37 are rejected under 35 U.S.C 103(a) as being unpatentable over Williams et al. in view of Bachman et al. (5,843,029). Williams et al. meets the claim limitations as described above but does not include the arc-shaped chamber and pivot angles with the stroke chamber.

However, Bachman et al. teaches a manual breast pump. Regarding claims 3-4, 24, 36-37, Bachman et al. discloses a curved arc shaped path for the piston path and the stroke path moves out of the plane (Figure 1).

Regarding claims 5-7, 25, 32, 33 Williams et al. discloses a retracting mechanism that has a spiral spring (32) that acts in tension and compression to place force on the piston head and uses support element (36) and is retained in the support cap with a snap in means (Figure 3).

At the time of the invention, it would have been obvious to use the curved arc path of Bachman et al. with the piston system of Williams et al. because the addition of the arced piston path provides an easier to grip and use piston pump system that can better make it easier for the user to pump the system. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Bachman et al

Claims 8 and 29 are rejected under 35 U.S.C 103(a) as being unpatentable over Williams et al. in view of Niederberger (5,810,772). Williams et al. meets the claim limitations as described above but does not include an electric pump to augment the manual pump.



However, Niederberger teaches a mother's milk pump. Regarding claims 8 and 29, Niederberger discloses a breast pump system with an electric pump that attached via a tube assembly (Figure 1).

At the time of the invention, it would have been obvious to use the electric pump of Niederberger with the manual system of Williams et al. because the addition the electric pump provides the manual system with an alternative automated pump action to make the use of the device easier. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Niederberger.

Claims 9 and 30 are rejected under 35 U.S.C 103(a) as being unpatentable over Williams et al. in view of Niederberger in further view of Bachman et al. (5,843,029). Williams et al. and Niederberger meet the claim limitations as described above but does not include the connecting element that is - in shape.

However, Bachman et al. teaches a manual breast pump. Regarding claims 9 and 30, the reference teaches a connecting element between the bore and cap that is conical in shape (76).

At the time of the invention, it would have been obvious to use the conical ring of Bachman et al. with the system of Williams et al. The addition of the sealing ring provides the system with additional vacuum leak resistance. Both references are analogous in the art and with the instant invention; therefore, a combination is proper.

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Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Bachman et al.

Claims 10, 31, and 43 are rejected under 35 U.S.C 103(a) as being unpatentable over Williams et al. in view of Niederberger in further view of Bachman et al. in further view of Kirchner (4,583,970). Williams et al., Niederberger, and Bachman et al. meets the claim limitations as described above but does not include a hole that can be used to adjust the vacuum level.

However, Kircher teaches a milk suction device. Regarding claims 10, 31, and 43, the reference teaches ventilation opening which can be covered by the hand to adjust the vacuum pressure (21).

At the time of the invention, it would have been obvious to use the ventilation opening of Kircher with the system of Williams et al. The addition of the ventilation opening allows the user to manually adjust the vacuum pressure level for better usage. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Kircher.

Claims 44, 47-54 are rejected under 35 U.S.C 103(a) as being unpatentable over Williams et al. in view of Meyers et al. (5,542,921). Williams et al. meets the claim limitations as described above but does not include a secondary air-regulating unit.

However, Meyers et al. teaches an electric breast pump. Regarding claims 44, and 47-54 the reference teaches a secondary ventilation device that can be manually

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operated (Figure 5) that can be rotated and connects to the conduit (Figure 2) and is covered by a cap.

At the time of the invention, it would have been obvious to use the secondary air regulator of Meyers et al. with the assembly of Williams et al. The addition of the secondary air regulator provides a better way to adjust the vacuum pressure. Both references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Meyers et al.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on Monday through Friday 7:30am-4:00pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/25/06  
[Date]

  
Christopher Koharski  
Examiner  
Art Unit 3763

  
CHRISTOPHER KOHARSKI  
EXAMINER  
ART UNIT 3763